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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996.739	11/30/2001	Claude A. Marbler	ATM-2301	4484

7590 12/18/2003

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,739

Applicant(s)

MARBLER ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-29,31,33-35,37-48 is/are pending in the application.
- 4a) Of the above claim(s) 15,18,19,28,29,31,33-35 and 37-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-29,31,33-35 and 37-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 12-27, drawn to a process, classified in class 156, subclass 46.
 - II. Claims 28-29, 31, 33-35, 37-47, drawn to a product, classified in class 428, subclass 43.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as not cutting the perforations completely through the film.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Species I: Claim 14 directed to a process step wherein the perforations are cut before coating the film with adhesive. Species 2: Claim 15

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directed to a process step wherein the perforations are cut after coating the film with adhesive.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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During a telephone conversation with Mrs. Armstrong on 11/24/03 a provisional election was made without traverse to prosecute the invention of Group I, claims 12-27 and Species I. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15,18,19, 28,29,31,33-35,37-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Rejections Withdrawn

2. The 35 U.S.C. 102 rejection of claims 12-13,15,18,19,23-29,31,33-35,37,39,41-42 anticipated by Olivieri et al. made of record in Paragraph 1 of Paper 7 has been withdrawn due to Applicant's amendment in Paper 14.
3. The 35 U.S.C. 103 rejection of claims 14,16,17,38 over Olivieri et al. in view of Heilmann et al. made of record in Paragraph 2 of Paper 7 has been withdrawn due to Applicant's amendment in Paper 14.
4. The 35 U.S.C. 103 rejections of claims 20-22,40 over Olivieri et al. in view of Schlaeppli et al. made of record in Paragraph 3 of Paper 7 has been withdrawn due to Applicant's amendment in Paper 14.

Claim Objections

5. Claim 40 is objected to because of the following informalities: Claim 40 is dependent on cancelled claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-14,20,27 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlaeppli (0596747).

Schlaeppli discloses a process comprising manufacturing a multilayer packaging film for a packaging (col. 3 lines 5-13) having at least one line of perforations (figure 1 8a) that are provided in a plastic surface layer of the packaging (col. 4 lines 15-40) and serve as an aid for alignment of a tear line propagating in the packaging film upon tearing open the packaging (col. 3 lines 2-4), including cutting the perforations completely through a film that is to be the precut plastic layer (col. 2 lines 56-57), each at least one line of perforation extending from edge to edge of the multilayer packaging film (figure 1 8a) and joining the precut film to the other layers to provide the multilayer packaging film (col. 3 lines 12-13), and providing a notch for initiating tearing in the region of the perforations (col. 1 lines 10-11), the packaging being easy to open by

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means of the tear line (col. 1 line 5). Schlaeppi discloses that the precut plastic layer is joined to the other layers by means of an adhesive layer to make up a composite film (col. 4 lines 19-20). Schlaeppi discloses that the perforations are cut before coating the film with adhesive (col. 4 lines 15-17). Schlaeppi discloses that the two lines of perforations are cut parallel or substantially parallel to each other (figure 1 8a and 8c) and a distance apart as guidelines on both sides of a tear which propagates in the film on tearing open the packaging (col. 3 lines 1-4). Schlaeppi discloses that the packaging film is employed for the production of pouch forms of packaging (col. 2 lines 29-30). Schlaeppi et al. teaches that the film is joined to the other layers by means of extrusion to make up a composite film (col. 4 lines 20-21).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 12-14,16-17,23-27 are rejected under 35 U.S.C. 102(e) as being unpatentable over Olivieri et al. (6427420).

Olivieri et al. discloses a process comprising manufacturing a multilayer packaging film for a packaging (col. 1 lines 6-7) having at least one line of perforations (figure 8a number 433) that are provided in a plastic surface layer of the packaging

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(col. 2 lines 58-68, figure 8 number 433) and serve as an aid for alignment of a tear line propagating in the packaging film upon tearing open the packaging (col. 8 lines 65-67), including cutting the perforations completely through a film that is to be the precut plastic layer (col. 7 lines 35-39), each at least one line of perforation extending from edge to edge of the multilayer packaging film (col. 10 lines 30-31) and joining the precut film to the other layers to provide the multilayer packaging film (col. 10 lines 17-20), and providing a notch for initiating tearing in the region of the perforations (figure 9a number 431), the packaging being easy to open by means of the tear line (col. 2 lines 53-54).

Olivieri et al. discloses that the precut plastic layer is joined to the other layers by means of an adhesive layer to make up a composite film (col. 10 lines 17-20). Olivieri et al. discloses that the perforations are cut before coating the film with adhesive (col. 10 lines 14-16). Olivieri et al. discloses that the two lines of perforations are cut parallel or substantially parallel to each other (figure 9a numbers 433 and 432) and a distance apart as guidelines on both sides of a tear which propagates in the film on tearing open the packaging (figure 9a numbers 433 and 432) and a notch is situated between the two lines of perforations (figure 9a number 431). Olivieri et al. discloses that the packaging film is employed for the production of pouch forms of packaging (col.1 lines 22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16, 17, 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlaeppi in view of Olivieri et al. (6427420).

Schlaeppi discloses the process comprising manufacturing a multilayer packaging film described above. Schlaeppi fail to disclose that the notch is situated between the two lines of perforations. Olivieri et al. teaches that the notch is situated between the two lines of perforations (figure 8a number 431) for the purpose of tearing the materials forming the pack (col. 8 lines 57-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Schlaeppi with the notch that is situated between the two lines of perforations in order to tear the materials forming the pack (col. 8 lines 57-58) as taught by Olivieri et al.

9. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivieri et al. in view of Schlaeppi et al. (0596747).

Olivieri et al. discloses the process comprising manufacturing a multilayer packaging film described above. Olivieri et al. fail to disclose that the film is joined to the other layers by means of extrusion to make up a composite film. Schlaeppi et al. teaches that the film is joined to the other layers by means of extrusion to make up a composite film (col. 4 lines 20-21) for the purpose of securing the inner and outer layers together (col. 4 lines 19-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Olivieri et al. with the film that is joined to the other layers by means of extrusion to make up a composite film in order to

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secure the inner and outer layers together (col. 4 lines 19-20) as taught by Schlaeppi et al.

Response to Arguments

Applicant's arguments with respect to claims 12-29,31,33-35,37-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

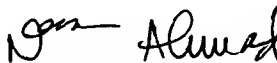
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee
December 11, 2003



NASSER AHMAD
PRIMARY EXAMINER